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Alan Young

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EXAMINER

SHAAWAT, MUSSA A

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/728,471
Filing Date: November 30, 2000
Appellant(s): YOUNG ET AL.

YOUNG, Alan, et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/19/2008 appealing from the Office action mailed 11/16/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appellant previously appealed a final rejection and filed an Appeal Brief on November 17, 2006, whereupon on November 16, 2007, the examiner reopened prosecution with a new final rejection which necessitated the present appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

Appellant's brief presents arguments relating the examiner reopening prosecution with a new final rejection which necessitated the present appeal. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20050027610	Wharton	02/03/2005
2003006922	Arunachalam	04/10/2003
5,878,141	Daly et al.	03/02/1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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1. Claims 1, 4-7, 9, 10, 12, 14-16, 23, 25, 46 and 62-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton (2005/0027610), in view of Arunachalam (2003/006922) and in further view of Daly et al, US Patent No. (5,878,141) referred to hereinafter as Daly.

Wharton discloses a method and system for data management of an electronic transaction with the steps of: receiving an order from an interface-enabled communications device via a wireless communication network coupled to the transaction portal server (step 78-84), retrieving product information data from the product database of the merchant by the merchant server via the wireless communication network coupled to the transaction portal server (via vendor catalog), receiving payment option data comprising information describing a desired means of payment for the product by the merchant check-out application of the merchant server from the interface-enabled communications device via the wireless communication network coupled to the transaction portal server (§ 0041), transmitting payment authorization data to a the payment processor by the transaction portal server (§ 0047; via verifying the merchant and customer identification information against that stored in the databases, and conducting payment verification functions via the payment proxy (and perhaps according to a runtime payment verification script obtained from the merchant database), receiving authorization from the payment processor (12) by the transaction portal server (32), and transmitting order information to a check-out application of the merchant server by the transaction portal server (§ 42-47).

Wharton further discloses displaying and selecting product code associated with the product (via entry items 44E that described the purchased items).

Wharton also discloses the product information comprises the price of the product, and name of the product, and the product code comprises a unique number assigned to the product (as illustrated in Figure 1, ¶ 0033). Providing an order confirmation to the interface enabled communications device (¶ 0046), and receiving customer identification information comprises receiving customer identification information from the interface-enabled communications device (¶ 0047), and wherein the interface enabled communications device comprises a web browser (such as the Internet; ¶ 0030). The interface-enabled communications device comprises a wireless telephone (¶ 0022), or at least one of the following: a personal computer (32).

The transaction portal server (32) is in communication with at least two merchant servers (34, 36, 38), and the desired means of payment for the product comprises a credit card (¶ 0041), and offering a product for purchase from a merchant comprises providing a hyperlink on the transaction portal server to a merchant server (¶ 0040).

Although Wharton discloses carrying out the order fulfillment so that the products get shipped to the right location, Wharton fails to explicitly disclose transmitting order information to a check out application of the merchant server by the transaction portal server, and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the transaction portal server, and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation

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information by the transaction portal server on the display screen of the wireless communication device for the customer .

Arunachalam discloses the concept of receiving in a transaction portal server (350) via a wireless communication switching facility coupled to the transaction portal server over a global network request entered by a customer on a wireless communication device (310) coupled to the wireless communication switching facility (see ¶ 51, 52). Arunachalam discloses the concept of having a default payment (via Visa node 1225) and further transmitting order information to a check out application (such as hub 1210 by the transaction portal server, and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the transaction portal server (see ¶ 0098-0099), and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation information by the transaction portal server on the display screen of the wireless communication device for the customer (¶ 0100).

From this teaching of Arunachalam, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the unified checkout step of Wharton to include the delivery information and confirmation of the service transaction as taught by Arunachalam in order to facilitate online transaction processing.

Furthermore:

Although Wharton teaches receiving payment option data comprising information describing a desired means of payment for the product by the merchant check-out application of the merchant server from the enabled-interface communications device via the wireless communication network coupled to the transaction portal server (see at least Para [0041]), Wharton does not expressly teach retrieving default payment method information for the customer by the transaction portal server from an electronic wallet.

However, Daly teaches retrieving default payment method information for the customer by the transaction portal server from an electronic wallet, (see col.12 lines 53-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Daly into the disclosure of Wharton in order to provide the customer with an added convenience by giving the customer the choice of using the default payment option previously utilized by the customer and not having to re-enter his/her payment information every time they would like to purchase a product on-line.

In addition, although Wharton teaches receiving an order from an interface-enabled communication device via a wireless communication network coupled to the transaction portal server, and retrieving product information data (such as SKU number i.e unique id, product identification, quantity and price, etc.), from the product database of the merchant by the merchant server via the wireless communication network coupled to the transaction portal server (see at least Para [0033]), Wharton does not expressly teach a customer entering a unique product and merchant identifying code.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Wharton to include customer entering a unique product and merchant identifying code, because doing so would identify the specific product of interest identified by the specific code.

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses them individually.

As per appellant's arguments filed on 05/19/2008, the appellant argues:

Argument 1: The examiner failed to comply with the requirement of 37 CFR 41.39(a)(2) to File an Examiner's Answer to previously Filed Appeal Brief setting forth the examiner's alleged new ground of rejection is improper (**see Appeal Brief, Page 11**).

In response to Argument 1, there is no requirement that limits the Office to provide New Grounds of rejection in an Examiner Answer, the Office has the right to reopen prosecution when it is appropriate to do so. In this case, the Office felt that it is appropriate to reopen prosecution with a New Final rejection. Therefore the office did not fail to comply since there is no requirement that limits the office to provide a New Grounds of rejection in Examiner Answer. In addition, this issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

Argument 2:

A) Wharton fails to teach or suggest transmitting order information to a check-out application of the merchant server by the transaction portal server and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the transaction portal server, and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation information by the transaction portal server on the display screen of the wireless communication device for the customer, as recited in claims 1 and 46 (**see Appeal Brief Page 13**).

B) Wharton teaches or suggests retrieving default payment method information for the customer by the transaction portal server from an electronic wallet server (**see Appeal Brief Page 14**).

C) Wharton does not teach or suggest a unique product and merchant identifying code entered by a customer on a wireless communication device.

In response to Argument 2, the examiner respectfully disagrees and would like to direct Board of Appeals and appellant's attention to the fact that Wharton was not relied upon to teach the claimed limitations mentioned above (A, B and C). Examiner relies on **Arunachalam to teach A**),

Although Wharton discloses carrying out the order fulfillment so that the products get shipped to the right location, Wharton fails to explicitly disclose transmitting order information to a check out application of the merchant server by the transaction portal server, and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the

transaction portal server, and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation information by the transaction portal server on the display screen of the wireless communication device for the customer.

Arunachalam discloses the concept of receiving in a transaction portal server (350) via a wireless communication switching facility coupled to the transaction portal server over a global network request entered by a customer on a wireless communication device (310) coupled to the wireless communication switching facility (see ¶ 51, 52). Arunachalam discloses the concept of having a default payment (via Visa node 1225) and further transmitting order information to a check out application (such as hub 1210) by the transaction portal server, and causing the electronic wallet server to complete payment and shipping information fields in an order fulfillment database of the merchant server by the transaction portal server (see ¶ 0098-0099), and receiving by the transaction portal server order confirmation information from the merchant server and displaying the order confirmation information by the transaction portal server on the display screen of the wireless communication device for the customer (¶ 0100).

From this teaching of Arunachalam, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the unified checkout step of Wharton to include the delivery information and confirmation of the service transaction as taught by Arunachalam in order to facilitate online transaction processing., Daly to teach B

Examiner relies on Daly to teach B),

Although Wharton teaches receiving payment option data comprising information describing a desired means of payment for the product by the merchant check-out application of the merchant server from the enabled-interface communications device via the wireless communication network coupled to the transaction portal server (see at least Para [0041]), Wharton does not expressly teach retrieving default payment method information for the customer by the transaction portal server from an electronic wallet.

However, Daly teaches retrieving default payment method information for the customer by the transaction portal server from an electronic wallet, (see col.12 lines 53-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Daly into the disclosure of Wharton in order to provide the customer with an added convenience by giving the customer the choice of using the default payment option previously utilized by the customer and not having to re-enter his/her payment information every time they would like to purchase a product on-line.

and examiner relies on Obviousness to teach C)

Although Wharton teaches receiving an order from an interface-enabled communication device via a wireless communication network coupled to the transaction portal server, and retrieving product information data (such as SKU number i.e unique id, product identification, quantity and price, etc.), from the product database of the merchant by the merchant server via the wireless communication network coupled to the transaction portal server (see at least Para [0033]), Wharton does not expressly teach a customer entering a unique product and merchant identifying code.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the disclosure of Wharton to include customer entering a unique product and merchant identifying code, because doing so would identify the specific product of interest identified by the specific code.

Therefore Wharton in view of Arunachalam in further view of Daly still meets the scope of the limitation as currently claimed.

Furthermore, the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Boyd and Ovadia into the disclosure of Pentel and the results would have been predictable to one of ordinary skill in the art.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mussa A Shaawat/
Examiner, Art Unit 3627
July 31, 2008

Conferees:

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

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